

## REMARKS

The Examiner indicated that Claims 1-17 and 38 are allowed and that method Claims 18-37 are rejected under 35 USC 101 as being directed to non-statutory subject matter. In particular, the Examiner found that these claims, though they recite a useful and concrete process, do not appear to claim a tangible result.

The applicants wish to note that Claim 18, as previously amended, is directed to a "method for measuring an out-of-plane deformation of an object surface ..." comprising a series of steps ending with the step of "calculating said out-of-plane deformation." Therefore, the claim recited, as its last step, the very objective of the claimed process, thereby producing as concrete and tangible a result as one could hope for. One skilled in the art could then use the knowledge of the surface out-of-plane deformation produced by the invention in any way deemed desirable for a particular application. None of these applications, though, needs to be part of the limitations required to define of the present invention.

Under the Guidelines currently used by the PTO to assess whether the "tangible result" prong of the test for utility is met, the process claim must set forth a practical application to produce a real-world result. See MPEP 2106 Sect. IV.C.2.(2)(b). In the present case, as described throughout the specification, the need

addressed by the invention is the ability to measure sample deformations occurring during interferometric measurements as a result of operational motion of the sample as well as vibrations and any other source of shape change. See page 1, lines 8-9 and 17-21, for example. This need is a real-world problem, as indicated in the referenced passages of the specification. Thus, its solution by definition provides a real-world result that meets the tangible-result requirement of the Guidelines.

Therefore, the applicants respectfully submit that the language of Claim 18, as previously presented, recited subject matter that meets the requirements for patentability set out in the State Street case. However, the applicants are further amending the claim to recite the additional step of "utilizing said out-of-plane deformation to determine a motion of the object surface during operation of the object." This is exactly the need described by the language on page 1 of the specification. Accordingly, the requirements of the Guidelines are believed to be even more clearly met.

For the record, inasmuch as the previous amendment of Claim 18 has already affected its entitlement to equivalence under current law, this additional amendment is not believed to further affect its scope. Therefore, it is being submitted to facilitate the Examiner's acceptance of the applicant's argument in support of the claim's recitation of statutory subject matter.

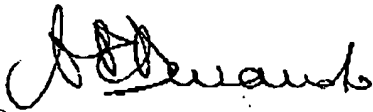
Claim 18 has also been amended to recite an object surface "in an object" in the preamble to provide antecedent basis for the "operation of the object" language in the body of the claim. Finally, Claim 1 was amended to re-insert the word "and" that was erroneously deleted in the previous amendment to the claim.

In view of the foregoing, the applicants believe that all claims recite patentable subject matter and reconsideration of the rejection of Claims 18-27 is respectfully requested.

It is noted that the last office action was indicated as non-final in the Action Summary and as final in the Detailed Action. Inasmuch as Claims 18-37 were not rejected on prior art and the limitation added to Claim 18 did not change the nature of the claim, and also because the statutory-subject-matter rejection was first raised in the last action, it is respectfully submitted that this action should not be final. Therefore, the Examiner is respectfully urged to enter the amendment submitted with this response.

No fee is believed to be due with this response. However, should any amount be required with this response, please charge it to our Deposit Account No. 04-1935.

Respectfully submitted,



Antonio R. Durando  
Reg. No. 28,409  
520-243-3383 Direct Phone  
520-577-6988 Direct Fax